



Docket No.: M4065.0660/P660
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Howard E. Rhodes et al.

Application No.: 10/689,712

Confirmation No.: 4640

Filed: October 22, 2003

Art Unit: 2815

For: AN OPTIMIZED PHOTODIODE PROCESS
FOR IMPROVED TRANSFER GATE
LEAKAGE

Examiner: J. A. Fenty

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the election requirement set forth in the Office Action mailed October 4, 2006, applicant hereby elects with traverse the species directed to an image pixel structure, as covered by claim sets 1-28, 78-82, and 83-94.

Applicant traverses the requirement because the Office Action does not state a proper basis for determining the claimed inventions are independent; and does not state why it would be a serious burden to collectively examine the claims directed to an image pixel structure (claims 1-28 and 78-94) and claims directed to a pixel imager system (claims 54-77).

Initially, Applicant notes that though the election requirement was apparently issued in view of differences between new claims 83-94 and previously presented claims 1-28 and 54-82, the Office Action does not require an election between those sets of claims. Rather, the Office Action requires an election of claims 1-28 and 78-94 directed to an image pixel structure or claims 54-77 directed to a pixel imager system. As a result, it is difficult to understand the basis of the election requirement.

The Office Action states, "The species are independent or distinct because the image pixel structure does not require the elements of the pixel imager system, notably the processor, CMOS imaging device nor pixel array." (Office Action, October 4, 2006, page 2). The above statement suggests the examiner has determined that the claims directed to an image pixel structure (claims 1-28 and 78-94) and the claims directed to a pixel imager system (claims 54-77) are independent of one another. However, that determination is incorrect. According to the MPEP:

Inventions as claimed are **independent if there is no disclosed relationship** between the inventions, that is, they are unconnected in design, operation, and effect. If it can be shown that two or more inventions are independent, and if there would be a serious burden on the examiner if restriction is not required, applicant should be required to restrict the claims presented to one of such independent inventions. **For example:**

(A) Two different combinations, **not disclosed as capable of use together**, having different modes of operation, different functions and different effects are independent. **An article of apparel and a locomotive bearing** would be an example. A process of painting a house and a process of boring a well would be a second example.

MPEP § 806.06 (emphasis added). The claimed image pixel structure and claimed pixel imager system are clearly capable of being used together. The Office Action appears to assert that the claimed imager pixel structures and pixel imager system are

independent merely because they have some different features. That is not the analysis required by the MPEP.

Furthermore, the examiner has not shown a “serious burden”. The MPEP states:

Where the related inventions as claimed are shown to be independent or distinct under the criteria of MPEP § 806.05(c) - § 806.06, the examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden on the examiner if restriction is not required. Thus the **examiner must show by appropriate explanation one of the following:**

(A) **Separate classification** thereof: This shows that each invention has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

(B) **A separate status in the art** when they are classifiable together: Even though they are classified together, each invention can be shown to have formed a separate subject for inventive effort when the examiner can show a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

(C) **A different field of search:** Where it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention(s) (e.g., searching different classes/subclasses or electronic resources, or employing different search queries, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

MPEP § 808.02 (emphasis added). The Office Action does not provide “an appropriate explanation” as to why there would be serious burden on the examiner if an election is not required. The Office Action merely explains:

[W]ith applicant's amendment filed 07/19/06 adding new claims 83-94, applicant is demonstrating that the image pixel structure claims are much more detailed and encompassing. The number of independent claims have increased, as well as the number of depending claims.

This amendment will cause the examiner to **search longer** in each of the invention classes and subclasses, and **apply different sets of prior art** to each of the inventions.

(Office Action, October 4, 2006, pages 3-4) (emphasis added). Neither the need to search longer within the same classes/subclasses nor to apply different sets of prior art meets the required showing of a "serious burden".

Accordingly, for the reasons stated above, Applicant respectfully requests that the election requirement be withdrawn.

Applicant's election is made without prejudice. As noted by the Examiner, upon the allowance of a generic claim, Applicant will be entitled to consideration of claims to not more than a reasonable number of species in addition to the elected species, provided that all claims to each additional species are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.146.

An action on the merits of all the claims and a Notice of Allowance thereof
are respectfully requested.

Dated: November 1, 2006

Respectfully submitted,

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